



Docket No.: 1163-0479P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hideaki MURAKAMI

Application No.: 10/698,481

Confirmation No.: 3225

Filed: November 3, 2003

Art Unit: 3683

For: CUSHIONING BODY

Examiner: M. Torres

REPLY BRIEF

MS Reply Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits herewith a Reply Brief in triplicate as required by 37 C.F.R. § 1.192.

This Brief on Appeal responds to the Examiner's Answer dated July 19, 2006.

For clarity, the issues presented in the Appeal Brief filed May 25, 2006, will be repeated, and the Reply to the Examiner's Answer will substantially correspond structurally to the arguments section in the Appeal Brief.

I. ISSUES ON APPEAL

The issues to be resolved in this application are:

1. Claims 1, 5, 6, 8-10, and 13 are anticipated under 35 U.S.C. § 102(b) over *Umezawa*; and
2. Claims 11, 12, and 14 are unpatentable under 35 U.S.C. § 103(a) over *Umezawa* in view of *Hsu*.

II. NEW POINT OF ARGUMENT RAISED BY THE EXAMINER'S ANSWER

Appellant is providing this Reply Brief to respond to new points of argument raised in the Examiner's Answer. Appellant does not disagree with paragraphs (9) – (10) of the Examiner's Answer. The specific new points of argument that are raised in paragraph (10) to which the Appellant disagrees are summarized as follows:

1. Examiner provides additional reasoning and support from the *Umezawa* reference to bolster the rejections of claim 1, 5-6, 9 and 10. With regard to claims 1 and 13, the Examiner provides arguments regarding the inherent properties of rubber; and further discusses additional embodiments in *Umezawa* in support of the rejection. With regard to claim 5, the Examiner provides a new interpretation of the term sheet in order to support the rejection. With regard to claim 6, the Examiner again takes an overly broad definition of the term sheet having a roughened surface. With regard to claim 9, the Examiner takes issue with the claim feature "heat radiating elastic member having resistance to heat". Because the claim language is purportively relatively broad and there is allegedly no specifics of resistance to heat recited in the claim language. Regarding claim 10, the Examiner asserts "that

it is old and well known that the heat radiating elastic member of *Umezawa* ... will isolate certain degree of vibrations." Moreover, the Examiner asserts that the claim language is "relatively broad and no specifics as to degree of vibrations." Response to these assertions are discussed in Paragraph A below.

2. The Examiner introduces new support for his rejections of claims 11, 12, and 14. The Examiner asserts that Hsu teaches a container having a cover 10 with electrical components 48, 50 inside the container mounted on a board 52 via shielding gasket 28 (cushioning body) to reduce electromagnetic interference among the electrical components. Appellant's response to the Examiner's assertions is discussed in Paragraphs B- F below.

III. REPLY

A. The Rejection Fails to Establish a *prima facie* Case of Anticipation of Independent Claims 1 and 13

In response to Appellant's arguments submitting that the Examiner's assertion that the use of rubber would inherently provide cushioning for protection from physical shock, the Examiner maintains that the inherency argument is proper. The Examiner further now asserts that "Since rubber is an elastic material, it is old and well known in the art that an elastic material such as rubber is resilient and flexible and are widely used as cushion and shock absorber." (See Examiner's Answer: page 5, paragraph 1). In this instance, it appears that the Examiner is shifting an inherency argument, which essentially states that rubber must be elastic and cushioned from shock, to arguments where the Examiner is taking Official Notice, wherein it is

old and well known that an elastic material may be used as "cushion and shock absorber." Whether the Examiner is asserting an inherency argument, or an Official Notice argument, Appellant maintains that this is improper. For example, in the *Umezawa* reference itself, for which the Examiner is asserting the rubber elastic material is disclosed. *Umezawa* specifically states that the Vicat softening temperature of the methacrylic resin is generally 100°C - 120°. When the thermoplastic resin sheet 12 is heated at a temperature within the above mentioned temperature range, it is thermosoftened to a rubber state (see col. 7, lines 4-14). Appellant submits that the material set forth in *Umezawa* could not be used as a cushioning member because as *Umezawa* discloses, it must be heated to at least 100°C to achieve a rubber state. Accordingly, Appellant maintains it is not inherent for the rubber as disclosed by *Umezawa* to be used as a cushioning member. Moreover, it would not be "old and well known in the art" that an elastic material of this kind, as disclosed by *Umezawa*, to be used as a cushioning member.

In the final Office Action dated December 30, 2005, the Examiner used in support of the rejection of independent claims 1 and 13 embodiment 4 described in column 14. In that embodiment, the thermoplastic resin sheet 12 took the form of an olefin-type elastomer sheet which had a thickness of .2 mm. (See col. 14, lines 5-12.) In col. 13, embodiment 3 further describes using soft laminates sheets which could be used to fabricate bags that can be used as electromagnetic wave shielding to cover medical devices. (See col. 13, line 58 - col. 14, line 2.) Again, these embodiments relied upon for the rejection only disclose the sheet having a thickness t_1 of resin layer 2 which was approximately 0.2 mm (col. 13, lines 37-39). In the Examiner's Answer, the Examiner provides new support in *Umezawa* to attempt to support the rejection of claims 1 and 13 by indicating that *Umezawa* discloses that "the preferable thickness t_1 of the

thermoplastic resin sheet 12 is approximately .15 to 6 mm." Appellant responds that this range covers a large variety of embodiments, and the thickness is not based upon providing the cushioning ability, but is driven by the ability to embed conductive mesh-like sheet 13 at a sufficient depth so that the thermoplastic resin sheet 12 and the conductive mesh-like sheet 13 can be laminated into an integrated body with sufficient strength. (See col. 6, lines 11-17.) Moreover, *Umezawa* further discloses that the greater thicknesses are also desirable so that the thermoplastic resin sheet 12 has better optical properties for the laminated sheet. (Col. 6, lines 42-44).

Appellant submits that the Examiner is impermissibly interchanging the various embodiments of *Umezawa* in an attempt to sustain an improper rejection.

Moreover, the Examiner asserts that the feature "to provide cushioning for protection from physical shock" as recited in claim 1, and "provides cushioning for protection from physical shock as recited in claim 13 "are relatively broad and no specifics as to the degree or amount of cushioning needed for protection from physical shock." (sic) (Examiner's Answer: page 5, lines 12-16). Appellant submits that the Examiner's assertion regarding the scope of claims 1 and 13 as being broad are insufficient to maintain an anticipation rejection. Appellant further submits that nowhere in *Umezawa* is it disclosed that the thermoplastic resin sheet is to be used for cushioning.

Furthermore, the Examiner asserts that Appellant is mixing arguments when asserting that the thermoplastic sheet 12 as disclosed by *Umezawa* is manufactured by using a 3mm thick sheet of silicone rubber. The Examiner further asserts that this disclosure in *Umezawa* has no

bearing on the cushioning properties of *Umezawa's* thermoplastic sheet. Appellant respectfully disagrees and submits that if the thermoplastic sheet had cushioning abilities, there would be no need to provide a 3 mm thick sheet of silicone rubber during its manufacturing. It is therefore respectfully submitted that claims 1 and 13 are not anticipated by the disclosure of *Umezawa*.

B. The Rejection Fails to Establish *prima facie* Anticipation of Dependent Claim 5

In order to maintain the rejection of claim 5, the Examiner is asserting that the mesh is indistinguishable from a sheet. Appellant respectfully disagree and submit that the full definition of a mesh is "an open worked fabric or structure; a net or network." (The American Heritage Dictionary of the English Language, 4th Edition). The term sheet is defined as "a broad flat continuous surface or expanse." (The American Heritage Dictionary of the English Language, 4th Edition). Appellant asserts that because the mesh is not continuous, it is not interchangeable with the term "sheet" as suggested by the Examiner. Appellant therefore respectfully submit that claim 5 is not anticipated by the disclosure of *Umezawa*.

C. The Rejection Fails to Establish *prima facie* Anticipation of Dependent Claim 6

The Examiner asserts on page 6 of the Examiner's Answer that "since a mesh consist of a network of wires put together forming as a fabric or sheet, the surfaces of mesh formed as a sheet have plurality of holes between network of wires which can be readable as having roughened surface which is relatively broad phrase with no specifics as to how the roughened surface is formed" (Examiner's Answer: Page 6, paragraph no. 3). As the Examiner admits, a mesh consists of a network of wires; however, the ordinary meaning of the term "sheet" is a broad flat continuous surface, as explained above. Appellant submits that it is inappropriate for the

Examiner to read a mesh as being interchangeable with a roughened surface. Appellant therefore respectfully submits that claim 6 is not anticipated by the disclosure of *Umezawa*.

D. The Rejection Fails to Establish A *prima facie* Case of Anticipation of Dependent Claim 9

In response to Appellant's argument that *Umezawa* fails to disclose the features recited in claim 9, the Examiner summarily disagreed asserting the language is relatively broad. Specifically, the Examiner merely asserted that *Umezawa* does disclose the features claimed in claim 9, and further asserted that there are no specifics of resistance to heat recited in the claim language. Appellant respectfully submits that the Examiner has failed to establish that *Umezawa* discloses "a heat-radiated elastic member having resistance to heat ..." as recited in claim 9 thus failing to satisfy his burden of establishing a *prima facie* case of anticipation. Moreover, Appellant submits that "specifics of resistance to heat recited in the claim language" is irrelevant for the purposes of establishing anticipation. Accordingly, Appellant respectfully submits that claim 9 is not anticipated by the disclosure of *Umezawa*.

E. The Rejection Fails to Establish *prima facie* Anticipation of Dependent Claim 10

The Examiner appears to be taking Official Notice stating that it is "old and well known that the heat-radiating elastic member of *Umezawa* made material such as from elastomer sheet are widely used as cushions and will isolate certain degree of vibrations." (sic) (Examiner's Answer: page 7, paragraph no. 1). The Examiner further asserts that "claim language is relatively broad and no specifics as to the degree of vibrations." Again, Appellant submits that the lack of specifics regarding vibration being recited in the claim language are not relevant for establishing

anticipation. Appellant submits that the Examiner must show where in the reference the recited claim language is set forth. Appellant submits that *Umezawa* fails to disclose a heat-radiating elastic member which isolates the magnetic wave generating unit from vibrations. Accordingly, Appellant submits that claim 10 is not anticipated by the disclosure of *Umezawa*.

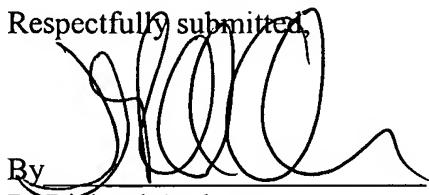
F. The Rejection Fails to Establish *prima facie* Obviousness of Dependent Claims 11, 12, and 14

In the Examiner's Answer, the Examiner set forth additional cites in *Hsu* to provide additional support for the rejection of claims 11, 12, and 14. The Examiner is asserting that *Hsu* is teaching an electrical board 52 having components mounted inside a container, which is mounted on the board 52 via a shielding gasket 28. It appears that the Examiner is asserting that the cushioning body is the shielding gasket. The Examiner further asserts that "it is old and well known that shielding gasket is used on an electronic device with a board." (See Examiner's Answer, page 7, paragraph 2). Appellant submits that it is unclear as to what the Examiner is relying upon for teaching the heat-radiating elastic member recited in claim 1 and incorporated by dependency in claims 11 and 12, and the heat radiating receptacle recited in claim 13 and incorporated by dependency in claim 14. Moreover, the Examiner fails to provide adequate motivation for combining the teachings of *Umezawa* with the teachings of *Hsu*. Accordingly, Appellant respectfully submits that claims 11, 12, and 14 are not rendered obvious over the teaching of *Umezawa* in view of *Hsu*.

IV. CONCLUSION

For all of the reasons set forth above, the rejections in the Examiner's Answer dated July 19, 2006, are improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

Dated: September 15, 2006

Respectfully submitted,
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